

REMARKS/ARGUMENTS

Further to the Examiner's restriction requirement of August 22, 2003, the Applicant elects Group I (claims 1 and 6-30) with traverse.

SUMMARY OF THE AMENDMENTS

Claims 31-69 have been withdrawn from the application.

The withdrawn claims may form the basis of one or more subsequent divisional applications.

DETAILED RESPONSE

On page 2 of the Office Action, the Examiner requires the restriction to one of the following groups of claims under 35 U.S.C. 121:

- I. Claims 1 and 6-30
- II. Claims 31-52
- III. Claims 53-63
- IV. Claims 64-69

In response, the Applicant elects group I (claims 1 and 6-30) with traverse. The Applicant respectfully disagrees with the Examiner that groups I, II and IV are unrelated. More specifically, the applicant respectfully submits that the examiner's conclusion regarding the independence of claim sets I, II and IV is erroneous.

Rather, the Applicant respectfully submits that groups I, II and IV are related.

On page 2 of the office action, the Examiner states that the inventions are distinct, each from the other because inventions I, II, III and IV are unrelated. In support of his conclusion, the examiner relies on MPEP §806.04 and MPEP §808.01 and states that:

“Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instant case the different inventions have both different modes of operations and functions.”

The Applicant respectfully submits that the test applied by the examiner, namely that the restriction requirement is proper because “different inventions have both different modes of operations and functions” was improperly applied because the aforementioned test can only be used if the inventions are unrelated in the first place.

As will be shown below, claims sets I, II and IV are not directed to unrelated inventions such as a necktie and a locomotive bearing. Rather, claims sets I, II and IV are directed to a computer readable medium, a method and an apparatus for computing a price. The applicant submits that claims sets I, II and IV are related to a common inventive concept. Consequently, the applicant respectfully submits that the restriction requirement for claim sets I, II and IV was improper and erroneous.

In support of the above, the applicant would like to direct the examiner’s attention to MPEP §808.01, which states the following:

“ Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04) the facts relied on for this conclusion are in essence the reasons for insisting upon restriction. This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

Form paragraph 8.20.02 may be used when claims are directed to independent, unrelated inventions.

¶ 8.20.02 Unrelated Inventions

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions [3].

Examiner Note

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing.

2. In bracket 3, insert reasons for concluding that the inventions are unrelated."

MPEP §806.04 states that an Applicant should be required to restrict the claims if it can be shown that two or more inventions are independent:

"(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process."

Group II (claims 31-52) is directed to a method of computing a price. Group I (claims 1 and 6-30) is directed to a computer readable storage medium for implementing the method of computing a price, as in claim 31. Group IV (claims 64-69) is directed to a server system for implementing the method of computing a price, as described by claim 31. For the Examiner's convenience, independent claims 31, 1 and 64 are reproduced below [emphasis added]:

Claim 31

A method for computing the price for shipping goods, comprising:

- a) **causing a computer to deliver first information to a user, the first information prompting the user to enter at the computer information about a rail transportation service for shipment of goods by one or more railcars;**
- b) **receiving information about a basic pool of railcars and filtering the basic pool of railcars based on one or more filtering criteria to produce a filtered pool of railcars;**

- c) causing the computer to deliver second information to the user, the second information prompting the user to select at the computer one or more railcars among the filtered pool of railcars for the shipment of goods;
- d) computing a price for the shipment of the goods at least in part on the basis of:
 - i) the rail transportation service;
 - ii) one or more characteristics of the railcars in the filtered pool of railcars selected by the user.

Claim 1

A computer readable storage medium containing a program element for execution by a CPU, said program element comprising:

- a) a first program component for **causing a computer to deliver first information to a user, the first information prompting the user to enter at the computer information about a rail transportation service for shipment of goods by one or more railcars;**
- b) a second program component for **receiving information about a basic pool of railcars,** said second program component implementing a filter for **filtering the basic pool of railcars based on one or more filtering criteria to produce a filtered pool of railcars,** said second program component **causing the computer to deliver second information to the user, the second information prompting the user to select at the computer one or more railcars among the filtered pool of railcars for the shipment of goods;**
- c) a third program element for **computing a price for the shipment of the goods at least in part on the basis of:**
 - i) the rail transportation service;
 - ii) one or more characteristics of the railcars in the filtered pool of railcars selected by the user.

Claim 64

A server system for computing a quote for a price for shipping goods by rail, said server system containing a program element for execution by a CPU, said program element comprising:

- a) a first program component for **causing a client system to deliver first information to a user, the first information prompting the user to enter at the client system information about a rail transportation service for shipment of goods by one or more railcars;**
- b) a second program component for **receiving information about a basic pool of railcars,** said second program component implementing a filter for **filtering the basic pool of railcars based on one or more filtering criteria to produce a filtered pool of railcars,** said second program component **causing the client system to deliver second information to the user, the second information prompting the user to select at the client system one or more railcars among the filtered pool of railcars for the shipment of goods;**
- c) a third program element for **computing a price for the shipment of the goods at least in part on the basis of:**
 - i) the rail transportation service;
 - ii) one or more characteristics of the railcars in the filtered pool of railcars selected by the user.

The Applicant respectfully submits that group I (claims 1 and 6-30) and group IV (claims 64-69) are directed to a computer readable storage medium and a server system respectively for implementing the method described by claim 31, and as such the claims of groups I, II and IV relate to the same general concept. Specifically, the computer readable storage medium of claim 1 and the server system of claim 64 both contain a program element for execution by a CPU, the program element

comprising a first program component, a second program component and a third program component for “causing a computer to deliver first information to a user, the first information prompting the user to enter at the computer information about a rail transportation service for shipment of goods by one or more railcars”, “receiving information about a basic pool of railcars”, “filtering the basic pool of railcars based on one or more filtering criteria to produce a filtered pool of railcars”, “causing the computer to deliver second information to the user, the second information prompting the user to select at the computer one or more railcars among the filtered pool of railcars for the shipment of goods” and “computing a price for the shipment of the goods at least in part on the basis of: i) the rail transportation service; ii) one or more characteristics of the railcars in the filtered pool of railcars selected by the user”.

Moreover, from the above-emphasized passages of claims 1 and 64, Groups I and IV are apparatus claims while Group II are process claims. As set forth earlier, MPEP §806.04 states that, “Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent.” In the present application, the computer readable storage medium of claim 1 is used to practice the process of claim 31, as shown above. Similarly, the server system of claim 64 is used to practice the process of claim 31, as shown above. Hence, the Applicant respectfully submits that both the computer readable storage medium and the server system as presently claimed are used to practice the method of computing a price.

Furthermore, the Applicant respectfully disagrees with the Examiner’s comments on page 2 of the Office Action that, “In the instant case, the different inventions have both different modes of operations and functions.” As already set forth herein above, the computer readable storage medium of claim 1 and the server system of claim 64 both contain a program element for execution by a CPU comprising a first program component, a second program component and a third program component for implementing the method described in claim 31. Thus, it is respectfully submitted that the mode of operations and functions do not differ, as the claims pertain to a

common concept in the form of a computer readable storage medium, a method and a server system.

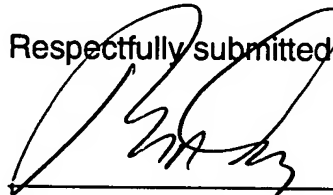
The Applicant therefore respectfully submits that Group I (claims 1 and 6-30), Group II (claims 31-52) and Group IV (claims 64-69) are related. Joint examination of the claims of Groups I, II and IV (i.e., claims 1, 6-52 and 64-69) on the merits is therefore respectfully requested.

CONCLUSION

The Applicant believes that claims 1, 6-52 and 64-69 should be jointly considered and are in allowable form. Favourable consideration is requested. The Notice of Allowance is earnestly solicited.

If the claims of the application are not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the assistance of the Examiner in making constructive suggestions or in drafting one or more acceptable claims so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. A. Dowell', is written over a horizontal line. To the right of the signature, the date '10/22/03' is handwritten.

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